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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,806	10/15/2003	Jana H. Jenkins	RSW920030214US1	5137
45541 7590 02/15/2007 HOFFMAN WARNICK & DALESSANDRO LLC 75 STATE ST 14TH FLOOR ALBANY, NY 12207			EXAMINER DAO, THUY CHAN	
			ART UNIT 2192	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/15/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/685,806

Applicant(s)

JENKINS, JANA H.

Examiner

Thuy Dao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/15/03 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the amendment filed on November 15, 2006.
2. Claims 1-8 and 10-21 have been examined.

Response to Amendments

3. Per Applicant's request, claims 1, 8, and 15 have been amended and claim 9 has been canceled.
4. The objection to the specification is withdrawn in view of Applicant's amendments.
5. The 35 USC §101 rejection over claims 8 and 10-14 is maintained.

Specification

6. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc. (i.e., "Under the present invention, an analysis criteria is provided.", line 1, emphasis added).

Appropriate correction is required.

Response to Arguments

7. The Applicant is thanked for a thorough reply. Applicants' arguments with respect to claims 1-8 and 10-21 have been considered but are moot in view of the new ground of rejection.

Claim Rejections – 35 USC §112, 1st paragraph

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-8 and 10-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 8, and 15:

Claim 1 is the representative claim of the group. The Applicant stated, *"For example, with independent claims 1, 8 and 15, Havens does not teach, inter alia, that the analyzed messages are "...delivered to an end user during execution of a computer program code...". This limitation is supported by paragraph [0004] of Applicant's original specification"* (Remakes, page 10, lines 2-5, emphasis added).

The examiner respectfully disagrees with this statement. The newly added limitations *"delivered to an end user during execution..."* contains subject matter which was not described in paragraph [0004]. Paragraph [0004] merely discloses *"...messages in properties files that are designed to support the product for the end-user"* (line 2) and briefly about certain types of messages (e.g., newly created, edited and/or deleted). Furthermore, the examiner cannot find other paragraphs which can support these newly added limitations.

Under the principles of compact prosecution, claims 1, 8, and 15 have been examined as the Examiner anticipates either the Applicant will point out other text portions/figures which fully/explicitly support these limitations or these claims will be amended to obviate these 35 USC §112, first paragraph rejection.

Claims 2-7, 10-14, and 16-21:

Claims 2-7, 10-14, and 16-21 are also rejected based on virtue of their dependency on rejected claims 1, 8, and 15, respectively.

Claim Rejections – 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. As set forth in the previous Office Action mailed August 15, 2006, claims 8 and 10-14 are rejected because the claimed invention is directed to non-statutory subject matter: "A system for analyzing messages", which are actually software program components as disclosed in Figure 2, Message Reporting System 18, and associated text in page 9, [0026].

The system (Message Reporting System 18) amounts to Functional Descriptive Material: "Data Structures" representing descriptive material per se or "Computer Programs" representing computer listings per se.

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast,

a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions. See MPEP 2106(I).

Under the principles of compact prosecution, claims 8 and 10-14 have been examined as the Examiner anticipates the claims will be amended to obviate these 35 USC §101 issues. The phrase has been treated as, for example, - A computer system for analyzing messages ... - as disclosed in Figure 1, wherein computer system 12 is a tangible system having CPU 20, Memory 22, said Message Reporting System 18...

Claim Rejections – 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-8 and 10-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Java and WebSphere Performance", IBM Redbooks, February 2002, section Performance Explorer PEX (art made of record, hereinafter "PEX-Feb02") in view of "Collecting and Analyzing PEX Trace Profile Data", IBM Rochester Lab, September 2002 (art made of record, hereinafter "PEX-Sep02"), and further in view of US Patent Publication No. 2003/0236992 A1 to Yami (art made of record, hereinafter "Yami")

Claims 1, 8, and 15:

PEX-Feb02 discloses a method, system, and program product (e.g., page 1, FIG. 1, page 1: 1 – page 2: 27; pp.3-5, sections 1.1-1.3) *for analyzing messages, delivered to*

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an end user during execution of a computer program code (e.g., page 41: 7-23), the method comprising:

providing message analysis criteria which identifies at least one computer program component (page 41: 24-26, member QAPEXDFN in library; page 44: 11-13, run one or more application transactions; page 44: 25-29, OrderEntryBeans.jar),

at least one properties file (e.g., page 41: 24-26, library QUSRSYS; page 42: 3-5, files QAYPExxx in QPEXDATA) and

designating desired information for at least one type of message (e.g., page 41: 12-17, desired information associated with 3 types of messages: Statistical, Profile, and Trace);

identifying instances of the at least one type of message based on the analysis criteria (e.g., page 42: 12-17, identifying report/result/log files as instances of Statistical, Profile, or Trace message); and

analyzing the instances to determine the desired information (e.g., pp.42-44, Performance Trace Data Visualizer; pp.48-51, Collecting performance data for analysis).

PEX-Feb02 does not explicitly disclose *[providing message analysis criteria which identifies] a predetermined time period.*

However, in an analogous art, PEX-Sep02 further discloses *[providing message analysis criteria which identifies] a predetermined time period* (e.g., page 2: 14-26, parameter INTERVAL(5) as a predetermined time period).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine the teaching of PEX-Sep02 into that of PEX-Feb02. One would have been motivated to do so to obtain shorter performance data collections on large systems as suggested by PEX-Sep02 (e.g., page 2: 20-26).

Neither PEX-Feb02 nor PEX-Sep02 explicitly discloses *[the desired information includes] a message quantity and an estimated line count.*

However, in an analogous art, Yami further discloses *the desired information includes a message quantity and an estimated line count* (e.g., [0030], [0045], [0055]).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine the teaching of Yami into that of PEX-Feb02 and PEX-Sep02. One would have been motivated to do so to provide secure log files as suggested by Yami (e.g., [0002] and [0006-0010]).

Claims 2, 9, and 16:

PEX-Feb02 also discloses *outputting the desired information* (e.g., page 48-51, Visualizer performance data with PTDV).

Claims 3, 10, and 17:

Yami further discloses *computing an estimated translation cost based on the estimated line count* (e.g., [0045], [0055]).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine the teaching of Yami into that of PEX-Feb02 and PEX-Sep02. One would have been motivated to do so as set forth above.

Claims 4, 11, and 18:

Yami further discloses *the estimated line count is computed by determining a total of words added, changed or deleted within the instances, and dividing the total of words by a predetermined value* (e.g., [0023], [0029]). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine the teaching of Yami into that of PEX-Feb02 and PEX-Sep02. One would have been motivated to do so as set forth above.

Claims 5, 12, and 19:

Yami further discloses *the predetermined value is ten* (e.g., [0053-0055]). It would have been obvious to a person having ordinary skill in the art at the time the

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invention was made to combine the teaching of Yami into that of PEX-Feb02 and PEX-Sep02. One would have been motivated to do so as set forth above.

Claims 6, 13, and 20:

Yami further discloses *at least one type of messages is selected from the group consisting of newly created messages, edited messages, and deleted messages, and wherein the instances of the at least one type of message are those that correspond to the at least one computer program component and that exist within the at least one properties file during the predetermined time period (i.e., [0023], [0045], [0053]).* It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine the teaching of Yami into that of PEX-Feb02 and PEX-Sep02. One would have been motivated to do so as set forth above.

Claims 7, 14, and 21:

Yami further discloses *the estimated line count represents a translation estimate for the newly created messages and the edited messages (e.g., [0029], [0053-0055]).* It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine the teaching of Yami into that of PEX-Feb02 and PEX-Sep02. One would have been motivated to do so as set forth above.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication should be directed to examiner Thuy Dao (Twee), whose telephone is (571) 272 8570. The examiner can normally be reached on Monday, Tuesday, Thursday, and Friday from 6:00AM to 4:30PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam, can be reached at (571) 272 3695.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273 8300.

Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the TC 2100 Group receptionist whose telephone number is (571) 272 2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

T. Dao



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